REMARKS

In the Office Action, the Examiner rejected claims 1, 3, 4, 6-9, 11, 12, 14, 15, 17-20, 22, 23, 25, 26, 28-31 and 33 and objected to claims 2, 5, 10, 13, 16, 21, 24, 27 and 32. As discussed in detail below, the Applicant hereby requests removal of the Aragones et al. reference (U.S. Patent No. 6,832,205) pursuant to 35 U.S.C. §§ 102(e)/103(c). Upon removal of the Aragones reference, all outstanding rejections will be moot. In view of the foregoing amendments and following remarks, the Applicant respectfully requests reconsideration and allowance of all pending claims.

Objection to the Specification

In the Office Action, the Examiner objected to the specification due to various informalities. Although the Applicant does not necessarily agree with the Examiner's objections, the Applicant hereby amends the specification as suggested by the Examiner to expedite allowance of the present application. In view of these amendments, the Applicant respectfully requests that the Examiner withdraw the objections to the specification.

Rejections Under 35 U.S.C. § 103

The Office Action summarizes claims 1, 3, 4, 8, 9, 11, 12, 14, 19, 20, 22, 23, 25, 26, 30, 31 and 33 as rejected under 35 U.S.C. §103(a) as being unpatentable over Aragones et al. (U.S. Patent No. 6,832,205; hereinafter "Aragones") in view of Richman et al. (U.S. Patent No. 6,631,384; hereinafter "Richman"); claims 6, 17 and 28 as rejected under 35 U.S.C. §103(a) as being unpatentable over Aragones in view of Richman, and further in view of Cece et al. (U.S. Patent No. 6,591,182; hereinafter "Cece"); claims 7, 18 and 29 as rejected under 35 U.S.C. §103(a) as being unpatentable over Aragones in view of Richman, and further in view of Cece and Gleeson et al. (U.S. Patent No. 6,317,654; hereinafter "Gleeson"). The Applicant respectfully traverses these rejections.

Request Removal of Commonly Assigned Reference under 103(c)/102(e)

Regarding the Aragones reference, the Applicant respectfully stresses that Aragones (U.S. Patent No. 6,832,205) must be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Aragones (U.S. Patent No. 6,832,205) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, General Electric Company, New York. Accordingly, the Applicant respectfully requests that the Examiner remove Aragones (U.S. Patent No. 6,832,205) from consideration. After Aragones (U.S. Patent No. 6,832,205) is removed according to 35 U.S.C. § 103(c), the Examiner's rejections based on Aragones (U.S. Patent No. 6,832,205) are moot. As summarized above, all of the outstanding rejections under 35 U.S.C. § 103 are based on Aragones. Thus, the Applicant respectfully requests allowance of all pending claims.

In addition, the Applicant stresses that the present claims are allowable over the cited references in view of the following legal precedent and remarks.

Legal Precedent

First, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); *see also In re Morris,* 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. *See id.*

Second, interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. *See In re Cortright*, 165 F.3d 1353,

1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *See Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." *See id.*

Third, the burden of establishing a prima facie case of obviousness falls on the Examiner. Ex parte Wolters and Kuypers, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a prima facie case, the Examiner must not only show that the combination includes all of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. Ex parte Clapp, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. In re Lee, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "'well within the ordinary skill of the art'" based on individual knowledge of the claimed elements cannot be relied upon to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d.

1313, 1318 (Fed. Cir. 2000); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Fourth, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." In re Dembiczak, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by independent claims 1, 12 and 23.

Independent claim 1 recites, *inter alia*, "an engine baseline modeling component that builds an engine baseline model for each of the plurality of groups using a regression analysis." Independent claim 12 recites, *inter alia*, "building an engine baseline model for each of the plurality of groups using a regression analysis." Independent claim 23 recites, *inter alia*, "one or more instructions for building an engine baseline model for each of the plurality of groups using a regression analysis."

Aragones fails to teach or suggest the foregoing features of independent claims 1, 12 and 23. Aragones teaches that an illustrative but non-exhaustive list could include delta exhaust gas temperature (dEGT), which is the deviation from the baseline EGT, fuel flow (WF), core speed (N 2), and EGT divergence, divEGT, which is the difference of

the EGT between the raw EGT of the engine in question and the mean of raw EGT of all engines. *See Aragones*, column 8, lines 5-9. In particular, Aragones teaches a system and method for automatically predicting timing and costs of future service events in a life cycle of a product. *See Aragones*, Abstract. Applicant submits that Aragones does not teach building an engine baseline model. Furthermore, Aragones does not teach building an engine baseline model for each of the plurality of groups using a regression analysis. For these reasons, among others, Aragones fails to teach or suggest each and every feature recited by independent claims 1, 12, and 23.

As a result, the cited references, taken alone or in hypothetical combination, fail to support a *prima facie* case of obviousness of independent claims 1, 12, and 23 and their dependent claims. For at least this reason, the Applicant respectfully requests withdrawal of the foregoing rejections.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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